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TRANSMITTAL LETTER

(General - Patent Pending)

Docket No.

96-200-C1

In Re Application Of: WALKER et al.

Application No.

09/632,295

Filing Date

August 3, 2000

Examiner

WEISBERGER, Richard

Customer No.

22927

Group Art Unit

3624

Confirmation No.

1956

Title: INSTANT CREDIT MARKETING SYSTEM

COMMISSIONER FOR PATENTS:

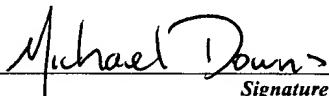
Transmitted herewith is:

Summary of Telephone Interview (8 pp.); and
Return Receipt Postcard.

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Signature

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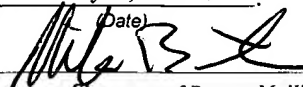
CUSTOMER NO. 22927

Dated: May 26, 2005

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Michael D. Brinton

Typed or Printed Name of Person Mailing Correspondence

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/632,295
Filed: August 3, 2000
Title: INSTANT CREDIT CARD MARKETING SYSTEM
Attorney Docket No.: 96-200-C1
Group Art Unit: 3624
Examiner: WEISBERGER, Richard
(571) 272-6753 /voice
(703) 872-9306 /fax

SUMMARY OF TELEPHONE INTERVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

With respect to the Telephone Interview held May 25, 2005, please consider the following remarks.

Applicants' representative files this document on behalf of the present Applicants for patent. Accordingly, references in this document to "we," "us," "our," and the like will be understood as indicating the present Applicants.

R E M A R K S

A. Telephone Interview

We would like to thank Examiner Weisberger for the courtesy of the telephone conversations (referred to collectively as “the Telephone Interview”) held on May 25, 2005, with Dean Alderucci and Mike Downs. We discussed various issues with respect to the pending application.

A.1. UNRESOLVED: Status of Claim 96

We stated that we believe that Claim 96 remains pending and was never withdrawn, even though the Office Action mailed October 13, 2004, did not list Claim 96 as pending.

The Examiner stated that he could not comment on the status of Claim 96 without first reviewing the file.

A.2. AGREED: Proper election of species was made

The Examiner agreed with us that we had properly provisionally elected “GROUP 1” and “GROUP B” with traverse in the Appeal Brief mailed January 14, 2005.

The Examiner indicated that he would issue an Interview Summary confirming the election with traverse was proper.

A.3. Examiner: Examiner’s election of species requirement is intended to “concentrate” examination and “advance prosecution”

The Examiner explained that the Examiner had chosen to impose the “election of species” requirement in order to “concentrate” examination. The Examiner explained an alleged benefit to Applicants of his requiring the “election of species,” using a “hub and spoke” analogy. The Examiner explained that we are being asked to elect one species (“spoke”) for examination along with its associated generic claim (“hub”). The Examiner explained that as a result of his requiring an “election of species,” if a “hub” claim is allowed, any of its “spokes” would also be allowed. The Examiner stated that we can “advance prosecution” by examining only a “hub” and a “spoke.”

The Examiner stated that he had decided that Claim 60 is “like a ‘hub.’” The Examiner stated that if “you look at the different species,” they are “not quite as related.”

A.4. Representative: No basis for requiring election of species

During the Telephone Interview, the Examiner stated that if “you look at the different species,” they are “not quite as related.”

We referred the Examiner to the Examiner’s only justification of record for requiring an election of species, in the Office Action mailed October 13, 2004, which is limited to only the following terse statement:

Upon further consideration of the claims, the nature [sic] the applicant’s requests and the applicant’s remarks directed the grouping of the claims (Appeal Brief, pg. 13), the following election of species is required.

We noted that how an appellant would group claims in response to prior art rejections is an inadequate basis for requiring election of species. We noted that the mere fact that claims may be different in scope is an inadequate basis for requiring election of species, and that claims must in fact be different in scope in order to be allowable. We noted that the record is otherwise devoid of any indication of why the Examiner is actually requiring an election of species.

In response, the Examiner questioned our motivation for arguing against the requirement to elect a species. The Examiner referred again to the alleged benefit to Applicants of “concentrating” examination. The Examiner stated that he did not understand how an election of species would be a disadvantage to an applicant.

We explained that such a requirement could result in the non-elected species remaining unexamined. The Examiner stated that he could not “argue with that.”

A.5. Examiner: Claims are “poorly written”

Following discussion of the restriction requirement, the Examiner asked us if we had considered “the merits” instead of only being concerned with the rules. We requested further clarification as to the meaning of “the merits.”

The Examiner asked us if we had considered “the claim construction.” We requested further clarification as to what exactly the Examiner was referring.

In response, the Examiner made a general statement that some of the claim language is “ambiguous.” We asked the Examiner to clarify the statement. The Examiner then said that the language is “not ambiguous.”

The Examiner then said that the language is “vague.”

The Examiner then referred to language recited in Claim 60: “obtaining an indication from a credit provider that a line of credit has been established.”

We asked if the Examiner was concerned about the breadth of the claims. The Examiner stated that he was not concerned with the breadth of the claims.

We stated that an indefiniteness rejection directed to “obtaining an indication” had been previously asserted and previously withdrawn.

The Examiner then expressed a belief that the pending claims are not the “best way” to claim the “invention.”

The Examiner then stated his belief that the claims are “poorly written.”

We requested that the Examiner be more specific as to what the Examiner was implying was wrong with the claims, as such information would be beneficial to Applicants. In response, the Examiner indicated that a forthcoming Office Action would include remarks that would clarify the Examiner’s concerns.

A.6. AGREED: Designated species are not mutually exclusive under § 806.04(f)

We and the Examiner discussed the test outlined in MPEP § 806.04(f) with respect to Claim 79 (designated as species “GROUP 1”) and Claim 82 (designated as species “GROUP 2”). The Examiner indicated he agreed that the disclosure would not support an understanding that the recited limitation of Claim 79 is disclosed only for a first species and not for any other designated species (*e.g.*, “GROUP 2”). In other words, the Examiner indicated an agreement that species “GROUP 1” and “GROUP 2” are not mutually exclusive under the test provided in § 806.04(f).

A.7. Examiner: Rejections cannot go to the Board but claims cannot be allowed

The Examiner stated that he did not feel comfortable sending the appealed rejections to the Board, but also “wasn’t comfortable allowing the claims.”

The Examiner stated that no new grounds of rejection had yet been determined.

The Examiner stated that although no search has yet been performed, a new grounds of rejection would be forthcoming.

A.8. Examiner: Required “election of species” is not “restriction”

The Examiner stated that the MPEP is not as clear as it could be with respect to restriction practices.

We noted that per MPEP § 806.04(f), in order for an election of species to be appropriate, the species must be mutually exclusive.

The Examiner stated a disagreement with our “interpretation” of the MPEP. The Examiner again stated that the MPEP is not clear. The Examiner suggested that we had confused a discussion of “restriction” with what is required for “an election of species.”

We stated that his statement was based on a plain reading of the literal language of § 806.04(f) “Claims Restricted to Species, by Mutually Exclusive Characteristics”: “Claims to be restricted to different species must be mutually exclusive.”

In response, the Examiner stated that the MPEP is not clear. He asserted that where § 806.04(f) refers to “species” in the first sentence (“Claims to be restricted to different species...”), the word “species” cannot be understood as referring to the practice of “election of species.”

The Examiner asserted that “restriction” or “restriction requirement” refers only the practice of restricting distinct or independent inventions. The Examiner asserted that “restriction” is different than and should not be used to refer to an “election of species.”

The Examiner asserted that use of the term “restricted” in the first sentence means that the whole of § 806.04(f) is referring to what the Examiner asserted is commonly known in the PTO as “restriction” or a “restriction requirement,” and cannot be referring to an “election of species.”

As best understood by us, what the Examiner consistently referred to as “restriction” or a “restriction requirement” would include such practices as restriction based on claims to combination and sub-combination, or based on claims to intermediate product and final product, but specifically does not include an “election of species.”

The Examiner stated a belief that because the Examiner has required an “election of species,” the Examiner does not have to establish that the designated species are mutually exclusive.

Applicants disputed this narrow interpretation of “restriction” with reference to several authoritative sources. We stated that MPEP § 802.02 “Definition of Restriction” explicitly defines restriction as a “generic term” that describes different practices, including “election of species.” We stated that given this explicit definition of what “restriction” is and the different practices it explicitly

covers, § 806.04(f) must be read as also addressing “election of species” where it says, “Claims to be restricted to different species must be mutually exclusive.”

We noted that Rule 146 “Election of species” explicitly states:

the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

We noted the use of the word “restrict” specifically with respect to “election of species.” The Examiner restated his belief that restriction practice is unclear.

The Examiner expressed a belief that MPEP § 806 is not relevant to “election of species.” The Examiner expressed a belief that MPEP § 809 is relevant to “election of species.” We pointed out that “generic” and “species” are terms used in § 809, and that definitions of those terms are provided in § 806.

We also referred the Examiner to § 809.02(a) “Election required.” We cited the explicit use in that section of the term “restrict” with respect to the outlined procedure for requiring an election of species:

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict.... See MPEP § 812.01 for telephone practice in restriction requirements....

* * *

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted....

* * *

If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted.

In response, the Examiner stated that the MPEP is ambiguous.

The Examiner asserted a belief that where it is “ambiguous,” the MPEP should be interpreted as supporting what is commonly understood by PTO personnel to be proper procedure.

A.9. Representative: No authority is provided in the new Board Rules for the Examiner to re-open prosecution in response to an appeal brief

We asserted that no authority is provided under the new Board Rules (37 C.F.R. §§ 41.1, et seq.) for the Examiner to re-open prosecution in response to an appeal brief.

We stated that any new grounds of rejection should, under new Board Rule 39, be included in an examiner's answer.

We noted that although the former rules indicated an examiner could re-open prosecution in response to an appeal brief, the new Board Rules do not include such an indication. We noted that Board Rule 39(a) "Examiner's Answer" indicates that an examiner may include a new grounds of rejection in an examiner's answer following an appeal brief. If the examiner does so, Board Rule 39(b) indicates that the appellant (not the examiner), may elect to re-open prosecution.

We requested that the Examiner indicate the authority relied upon to re-open prosecution in response to our Appeal Briefs.

In response, the Examiner stated that the Examiner was not aware of any rule that provided authority for the Examiner to re-open prosecution in response to our Appeal Briefs.

The Examiner stated that it is common in his "group" to re-open prosecution following an "appeals conference." The Examiner stated that re-opening prosecution following an appeals conference is common since the new Board Rules took effect in September 2004.

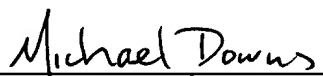
The Examiner stated that he believed he had never before re-opened prosecution in any application.

B. Conclusion

If the Examiner has any questions regarding the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

May 24, 2005
Date



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